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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,073

12/09/2005

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1204.45684X00

9636

20457 7590 04/22/2009
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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. **Continuation of Box 11:**

2. With respect to the 35 USC Section 102(b)/103(a) rejections based on Takeda et al. (US 2001/0035533A1), Applicant essentially continues to disagree with Examiner's position that the properties of SP value, weight average molecular weight, difference between heat generation initiating and peak temperatures and tan delta peak temperature and flow amount of the adhesive would necessarily be present in the invention of Takeda. To support his/her disagreement, Applicant asserts "Polyimides A-F of Takeda et al. respectively have Tg's, in °C of 212,187,200,170,142, and 115, each outside the scope of the present claims." (see page 17 of 04/10/09 amendment).

3. The Examiner respectfully disagrees with Applicant because while Applicant states that the polyimides of Takeda have different glass transition temperature than presently claimed, Applicant has provided no evidence to support this position. Therefore, said arguments are based on Applicant's personal opinion and without any factual evidence on the record. Applicant is respectfully reminded that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Additionally, the Examiner submits that the arguments provided by the applicant regarding the Takeda references must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

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The Examiner has reviewed Takeda reference and he is unable to find the support for Applicant's assertion "Polyimides A-F of Takeda et al. respectively have Tg's, in °C of 212,187,200,170,142, and 115, each outside the scope of the present claims."

4. Thus, given that Takeda discloses polyimide made from diamine and acid dianhydride as presently claimed and from process similar to that used in the present invention and absence evidence to the contrary, it is the Examiner's position that Takeda remains relevant reference against the present claims. Accordingly, Applicant's arguments are not found persuasive.

5. With respect to the 35 USC Section 102(b)/103(a) rejections based on Takashi (JP 11-140386), Applicant continues to disagree with Examiner's position that the properties of SP value, weight average molecular weight, difference between heat generation initiating and peak temperatures and tan delta peak temperature and flow amount of the adhesive would necessarily be present in the invention of Takashi. To support his/her disagreement, Applicant asserts "Polyimides A-C of No.11-140386 respectively have Tg's, in °C, of 114, 170, and 11, each also outside the scope of the present claims." (see page 17 of 04/10/09 amendment).

6. The Examiner respectfully disagrees with Applicant because while Applicant states that the polyimides of Takashi have different glass transition temperature than presently claimed, Applicant has provided no evidence to support this position.

Therefore, Applicant's arguments are based on Applicant's personal opinion and without

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any factual evidence on the record. Applicant is respectfully reminded that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Additionally, the Examiner submits that the arguments provided by the applicant regarding Takashi reference must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”. The Examiner has reviewed Takashi reference and he is unable to find the support for Applicant's aforementioned assertion.

7. Thus, given that Takashi discloses polyimide made from diamine and acid dianhydride as presently claimed and from process similar to that used in the present invention and absence evidence to the contrary, it is the Examiner's position that Takashi remains relevant reference against the present claims. Accordingly, Applicant's arguments are not found persuasive.

8. As to Applicant's arguments that comparative examples 3, 7, and 8 of Applicant's disclosure, using polyimides G or L, wherein the polyimides have Tg's outside the scope of the present claims, said arguments are not found persuasive, because Applicant has failed to compare his invention with the closest prior art (see MPEP 716.02(e)). Accordingly, Applicant's arguments are not found persuasive.

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9. **Continuation of Box 13:**

10. Applicant submitted IDS on 02/10/09 which cites a search report titled "Substantive Examination...". This search report cites two JP documents JP-A-8151554 and JP-A-9279121. It is noted that Applicant has not provided copies of the aforementioned documents. Thus, the Examiner is attaching machine translation of the aforementioned documents with this Advisory Action.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794